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09/586,651	06/01/2000	Thomas L. Stachura	42390P8731	5965

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EXAMINER

DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/01/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/586,651

Applicant(s)

STACHURA ET AL.

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. Claims 1-24 have been examined.

#### ***Drawings***

2. The drawings filed on 06/01/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. Formal drawings with corrections must be made in reply to this Office action. See 37 CFR 1.85(a).

#### ***Specification***

3. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the stored identification information" in page 17, line 2.

There is insufficient antecedent basis for this limitation in the claim.

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6. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the stored identification information" in page 18, line 19. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Dustan et al., U.S. Patent No. 5,884,312 A.

As per claims 1 and 9, Dustan et al. discloses a method and a machine readable medium comprising:

- a. generating an authentication result from comparing stored identification information with collected identification information of the organization property (see column 8, lines 16-21; figure 2, item 28; corporation graphical documents identified by a specific URL); and
- b. transmitting a plurality type of network packets containing the authentication result to a plurality of organization servers via a network (see column 11, lines 5-22; figure 2, item 54;

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allowing information to be exchanged among web servers of the Internet or servers of a corporate intranet by distributing the URL for the graphical documents).

As per claims 2 and 10, Dustan et al. further disclose:

retrieving the stored identification information and network addresses of the organization servers from a tamper-resistant storage location (see column 8, lines 38-47; figure 2, items 24 and 22; accessing the identification from the database server of the corporation).

As per claims 3 and 11, Dustan et al also elaborate:

assembling the plurality of types of network packets with the network addresses and information indicative of a current location of the organization property (see column 8, lines 38-47; combining with other information including the database server where the document is stored).

As per claims 4 and 12, Dustan et al. then point out:

- a. assembling and transmitting an intranet network packet to an intranet server (see column 11, lines 44-51; transmitting a request to a corporate intranet server; and
- b. in response to non-acknowledgment from the intranet server, assembling and transmitting an internet network packet to an internet server (see column 11, lines 49-60; in the event of improper interception resulting in no acknowledgment, implementing a Secure Socket Layer (SSL) protocol with a webserver on the internet).

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As per claims 5 and 13, Dustan et al. next explain:

retrieving the collected identification information from the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; the database server storing the URL corresponding to a particular script for a document with the document stored in the database server).

As per claims 6 and 14, Dustan et al. additionally mention:

retrieving the collected identification information from an electronic system that contains the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; the database server storing the URL corresponding to a particular script for a document with the document stored in the database server).

As per claims 7 and 15, Dustan et al. moreover describe:

that the collected identification information comprises an Internet Protocol address assigned to the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; where the client uses the URL of the graphical document to access it from the database server).

As per claims 8 and 16, Dustan et al. then specify:

that the collected identification information comprises device identification information of the electronic system (see column 12, lines 22-43; figure 2, items 22 and 28; the URL for the document indicates that it is stored at the database server).

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As per claim 17, Dustan et al. illustrate a theft prevention system comprising:

- a. a plurality of organization servers coupled to a network (see column 7, lines 8-15; figures 1 and 2, items 32, 34, 36, and 38; corporate data sources);
- b. a tamper-resistant storage location to maintain stored identification information of the organization property and network addresses of the organization servers (see column 12, lines 49-67; column 13, lines 1-10; figure 2, items 88 and 80; a database management system in conjunction with storage in the database server to initiate procedures to access documents);
- c. a theft monitor, coupled to the tamper-resistant storage location to generate an authentication result by comparing stored identification information with collected identification information of the organization property (see column 12, lines 23-35; comparing the client submitted URL with the stored URL in the database server to access the document; and
- d. a network access controller, coupled to the theft monitor, to transmit a plurality types of network packets containing the authentication result to the organization servers via the network (see column 11, lines 5-22; exchanging the document information with servers of the internet or servers of the corporate intranet).

As per claim 18, Dustan et al. further disclose:

retrieving the stored identification information and network addresses of the organization servers from a tamper-resistant storage location (see column 8, lines 38-47; figure 2, items 24 and 22; accessing the identification from the database server of the corporation).

As per claim 19, Dustan et al also elaborate:

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assembling the plurality of types of network packets with the network addresses and information indicative of a current location of the organization property (see column 8, lines 38-47; combining with other information including the database server where the document is stored).

As per claim 20, Dustan et al. then point out:

a. assembling and transmitting an intranet network packet to an intranet server (see column 11, lines 44-51; transmitting a request to a corporate intranet server; and

b. in response to non-acknowledgment from the intranet server, assembling and transmitting an internet network packet to an internet server (see column 11, lines 49-60; in the event of improper interception resulting in no acknowledgment, implementing a Secure Socket Layer (SSL) protocol with a webserver on the internet).

As per claim 21, Dustan et al. next explain:

retrieving the collected identification information from the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; the database server storing the URL corresponding to a particular script for a document with the document stored in the database server).

As per claim 22, Dustan et al. additionally mention:

retrieving the collected identification information from an electronic system that contains the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; the database



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server storing the URL corresponding to a particular script for a document with the document stored in the database server).

As per claim 23, Dustan et al. moreover describe:

that the collected identification information comprises an Internet Protocol address assigned to the organization property (see column 12, lines 22-43; figure 2, items 22 and 28; where the client uses the URL of the graphical document to access it from the database server).

As per claim 24, Dustan et al. then specify:

that the collected identification information comprises device identification information of the electronic system (see column 12, lines 22-43; figure 2, items 22 and 28; the URL for the document indicates that it is stored at the database server).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schultz et al., U.S. Patent No. 4,754,428 A discloses distributing electronic documents with identification information indicating their position
- Rubin et al., U.S. Patent No. 5,638, 446 A describes a digital signature technique for generating authentication information of a document

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- Sony Corp. (Iijima et al.), Japanese Patent Application Publication No. 09-282263  
present a system for using an identifier to account for and control equipment in a personal computer environment

### *Telephone Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is [justin.darrow@uspto.gov](mailto:justin.darrow@uspto.gov). The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an


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amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

June 28, 2004

  
**JUSTIN T. DARROW**  
**PRIMARY EXAMINER**  
**TECHNOLOGY CENTER 2100**